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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,623

09/30/2003

Bobbie Kaye Whitenton Baylis

2002P16242US01;60,427-605

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EXAMINER

GARCIA, ERNESTO

ART UNIT

PAPER NUMBER

3679

MAIL DATE

DELIVERY MODE

02/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/674,623	Applicant(s) BAYLIS ET AL.	
	Examiner Ernesto Garcia	Art Unit 3679	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 23-30.
 Claim(s) objected to: 13 and 32.
 Claim(s) rejected: 9,10,12,31 and 32.
 Claim(s) withdrawn from consideration: 1-5,8,21 and 22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☒ Other: See Continuation Sheet.

/Daniel P. Stodola/
Supervisory Patent Examiner
Art Unit 3679

Continuation of 3. NOTE: Re: item 3a: the amendment merely seeks to change the scope of the withdrawn claims and does not place the case in condition for allowance. No showing has been provided to explain why these changes were not earlier presented and are now necessary.

Continuation of 13. Other: Re: item 7b: With respect to applicants' remarks concerning the restriction requirement of September 25, 2007, it should be noted that such requirement was made in response to, and necessitated by, applicants' amendment filed June 29, 2007. In particular, applicants changed the scope of numerous claims from being drawn to a final product (the laser weld joint) to being drawn to an intermediate product (the component interface prior to laser welding). This "component interface" was never before presented and thus was not an originally presented invention that was even acted upon on the merits.

Applicants' remarks that the changes were only made in order to overcome a Section 112 rejection are acknowledged. However, this does not alter the fact that these changes have altered not only the scope of the claims, but the emphasis of the claims as well. Specifically, the claims are no longer drawn to the laser weld joint as was originally presented. Rather, they are now drawn to a component interface arrangement that is only present prior to the final weld joint. Applicants could have amended the claims in any number of ways to overcome or avoid the section 112 rejection then of record, including merely canceling the subject matter in question from the claimed final weld joint. Seeking to overcome a particular rejection does not give applicants license to make any change desired. The manner chosen by applicants, unfortunately, greatly altered the gist of the claim from what it had always been from the beginning.

Applicants further question how is the classification that would require Group I to be withdrawn different. In response, it should be noted that a component interface, not a weld joint, is different than an air induction component. The two subject matters are different since the gist of the assembly is now a container and the component interface is merely the bringing of any two parts together without requiring any weld in between. Applicant further remark that "this is the same classification that was proceeded with in response to the original restriction requirement". In response, it should be noted that the first restriction was based on the original claims and the second restriction was based between the "component interface" and the "air induction component assembly", which neither is a weld joint. Further, the search for Group II is not required for Group I since Group I has nothing to do with air induction assembly. Further, the different inventions impose a burden on the examiner since the examiner has to separately argue the different inventions.

Applicants believe that changing the preamble facilitates matters. In response, applicants should note that the addition of "for an air induction component assembly" (intended use) in the preamble does not structurally define or limit the component interface. The component interface is still a different invention as pointed out. Applicants further argue that claim 2 recites the components comprise air induction components. In response, it should be noted that claim 1 is still the broadest claim and does not require the particulars of claim 2 for patentability. Further, it should be noted that the original filed groups were put together since Group II required the particulars of the laser weld which is no longer required for Group I.

Applicants further remark that they fail to see how examining Group I puts a burden on the examiner because these claims are identified in a classification that was originally elected. In response, it should be noted that the examiner has never previously addressed the "component interface" since this was not originally presented. Further, it should be noted that classifications do not get elected but rather inventions get elected. Furthermore, applicants have failed to show that "search" is the only criteria that goes into determining the existence of a "serious burden". Accordingly, to have to examine two or more patentably distinct inventions of different scope in the same application, including consideration of individual arguments for each invention would impart a serious burden upon the examiner. Applicants further remark that the examiner continues to rejected the claims based on the previously cited prior art. In response, it is unclear how using the same art overcomes the restriction. Note that restrictions are not based on what art the examiner has used.

With respect to the specification objection, the applicants argue that paragraph 024 provides proper antecedent basis. In response, either the applicants have a different copy of the specification or the examiner cannot find the subject matter claimed. According to the Office's copy of the specification, paragraph 024 does not contain the term "directly" or for that matter "a second transition surface". Paragraph [024] mentions a transition surface 44 but it is unclear whether this is the first transition surface or the second transition surface. It would appear that this is the first transition surface since "the transition surface 44 connects an opposite end 46 of the tapered surface of the first laser weld surface 28".